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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/649,277	
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	First Named Inventor	Geoffry A. Westphal	
	Art Unit	2623	
	Examiner Name	LaRose, Colin M.	
Total Number of Pages in This Submission	10	Attorney Docket Number	31083.07US2

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Westphal et al.)	Examiner:	LaRose, Colin M.
)		
Application No.:	10/649,277)	Attny Doc.:	31083.07US2
)		
Filing Date:	August 27, 2003)	Art Unit:	2623
)		
Title:	System And Method For)		
	Image Compression, Storage)		
	And Retrieval)		

REPLY BRIEF

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Alexandria, VA 22313-1450

Dear Sir:

Appellants hereby reply to the Examiner's Answer of February 24, 2006.

This Reply Brief is being filed in triplicate.

The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment to deposit account number 50-2428 in the name of Greenberg Traurig.

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By: Ranni Matar
Ranni Matar

REMARKS

In accordance with 37 CFR §§ 41.41(a)(1) and 41.43(b), Appellant hereby submits this Reply Brief in response to the Examiner's Answer.

A. The Examiner's Answer As To The Rejection of Claims 1-24 and 28-39

It is respectfully submitted that the Examiner's Answer evidences that the Examiner has failed to consider these claims "as a whole" as is required. MPEP § 2141.02. Specifically, the Examiner's Answer evidences that the Examiner has failed to consider the order/sequence of the steps set forth within these claims which order **must** be considered when evaluating the patentability of these claims. *Loral Fairchild Corp. v. Sony Electronics Corp.* 181 F.3d 1313 (Fed. Cir. 1999). In this regard, the plain language of these claims sets forth a logical sequence of steps which have to be performed in their written order and, when performed in that written order, provide a system/method that functions to increase the number of images storable in a memory device. For example, similar to the facts set forth *Loral Fairchild Corp.*, the claim language itself indicates that the steps have to be performed in their written order because the "resultant images" cannot be "compressed" prior to the step of "altering," one of the "compressed, resultant images..." cannot be "selected" prior to the step of "compressing," the "selected one of the plurality of compressed, resultant images" cannot be "placed" into memory prior to the step of "selecting," etc. Thus, since the Examiner's Answer goes so far as to admit that that the cited references fail to suggest the invention claimed considering the sequence/order of the steps set forth in these claims (as well as the ultimate outcome resulting from the performance of the steps in the sequence/order set forth in these claims, namely, the resulting

increase in the number of images storable in a memory device), it is respectfully submitted that the rejection of claims 1-24 and 28-39 must be withdrawn.

Turning to the Examiner's Answer, in the Examiner's Answer it was acknowledged that Takagi fails to disclose, teach, or suggest at least the claimed compressing each of a plurality of resultant images or the claimed selecting from a plurality of compressed, resultant images created for each original image one compressed, resultant image which may then be placed into memory. In the Examiner's Answer it was further admitted that, "since Takagi's system *is directed to storing ultimately captured images on film, rather than digitally in some sort of file format*, Takagi does not disclose placing each of the (compressed) resultant images into a concatenation file and creating a look-up table for retrieving them from the file, as claimed." (Page 14, emphasis added). Thus, by the admissions within the Examiner's Answer, while Takagi is concerned with allowing a user to select and save from multiple, displayed images *a desired camera setting*, e.g., exposure, focus, and composition, to thereby allow for the capture on film of an image using the desired camera setting, Takagi simply does not disclose, teach, or suggest allowing a user to select from multiple displayed images, compressed or otherwise, an image which selected image is to be then digitally stored in memory as is claimed.

It was further acknowledged in the Examiner's Answer that Lee was relied upon for the express teaching that "when one wishes to display multiple images on a screen simultaneously, it is necessary to compress the images so that they fit on the screen." The Examiner's Answer then asserted (without citation to any passage from within Lee) that "Lee *appears* to disclose storing images digitally but does not expressly disclose placing compressed images into a concatenation file and creating a look-up table for retrieving images from the file as claimed." (Page 16, emphasis added). From this, the Examiner's Answer somehow concludes that the combination

of Takagi and Lee discloses all of the claim elements excepting the placing of the compressed resultant image into a concatenation file and creating a look-up table for retrieving the images from the file.

Considering now Lee, it is again respectfully noted that, while Lee may suggest storing images digitally, Lee does not disclose, teach, or suggest placing a selected one of a plurality of compressed, resultant images into any sort of memory, i.e., storing in memory a compressed, resultant image after it has been selected, as is expressly claimed. Rather, as concerns storing images digitally, Lee discloses nothing more than a compression method that requires the reading out of original image data already stored within memory and then displaying the original image data that is read from memory with predetermined horizontal and vertical lines omitted. Thus, like Tagaki, Lee does not disclose, teach, or suggest the desirability of placing into memory a selected one of a plurality of compressed, resultant images and, as such, the combination of Tagaki and Lee cannot be said to disclose the invention claimed excepting the placing of the compressed resultant image into a concatenation file and creating a look-up table for retrieving the images from the file as asserted in the Examiner's Answer. For at least this reason it is respectfully submitted that the rejection of claims 1-24 and 28-39 must be withdrawn.

Turning now to Kutcha which is being relied upon as allegedly disclosing those claim elements that have been acknowledged to be missing from the combination of Tagaki and Lee, it was acknowledged in the Examiner's Answer that Kutcha discloses a digital camera that stores images in a format that includes both reduced and high resolution versions of an original image. As noted in the Appeal Brief, the camera disclosed within Kutcha allows for the storage of images in this manner to offer the advantage of "quick review of images captured by or stored in the camera *prior to further processing or selection.*" Thus, Kutcha, which expressly teaches the

desirability of storing compressed, thumbnail images prior to processing or selection, not only teaches directly against the system claimed, i.e., one in which the original content of images are processed prior to compression, selection, and storage, but also fails, by the Examiner's own admission in the Examiner's Answer, to disclose, teach, or suggest modifying Takagi to allow for the storage of images after they have been selected. In this regard, the Examiner correctly notes that Kutcha, at best, only suggests modifying Lee and Takagi such that "all of the 'selected' images have already been 'placed' into a concatenation file (i.e., stored) at the time of selecting." (Page 18, emphasis added). Thus, by the Examiner's own admission, Kutcha can suggest nothing more than modifying Takagi and Lee such that the Takagi camera stores compressed, thumbnail versions of images prior to their display which displayed images may then be selected only to establish a desired camera setting and, as such, cannot be said to suggest modifying Takagi to arrive at the claimed invention which expressly requires first selecting from a plurality of compressed, resultant images...one compressed resultant image and then placing each of the selected ones of the plurality of compressed, resultant images into memory, e.g., into a concatenation file. For this further reason it is respectfully submitted that the rejection of claims 1-24 and 28-39 must be withdrawn.

That the Examiner has not considered the claims "as a whole" is still further evidenced by the fact that the Examiner admits that the nexus between the claim steps of "selecting from the plurality of compressed, resultant images created from each of the plurality of original images one compressed, resultant image" and "placing each of the selected one of the plurality of compressed, resultant images into a concatenation file" and the resulting advantage in performing these steps in the sequence set forth, namely, increasing in the number of images storable in a memory device, was not considered when determining the patentability of the

claims. (Page 20). In this regard, while the independent claims may not restrict how the selection of the image is made (since in some instances it may be desirable to sacrifice some size for quality), the fact remains that the step of “selecting” an image is still followed by the step of “placing *the selected*” image into memory which combination of steps the Examiner has admitted is not disclosed, taught, or suggested by the cited references. Nevertheless, to demonstrate that a nexus does exist between the steps in the invention claimed and to address the Examiner’s statement that “the claims do not specify that ‘the resultant image with the smallest compressed file size for each original image is selected,’” (Page 19) it is respectfully noted that claim 12 recites “[t]he method as recited in claim 1, wherein the selected one of the compressed, resultant images has the smallest file size.”

It is additionally respectfully submitted that the Examiner’s Answer further continues to fail to provide any explanation as to why one of ordinary skill in the art would have been motivated to use the mutually contradictory teachings of Lee and Kutcha, which admittedly pertain to diverse methods for allowing digitally captured images to be stored and accessed in a manner that facilitates their display on a camera and which as noted in the Appeal Brief are not properly combinable when the disclosures thereof are considered in the entirety as is required, to modify the system of Takagi, which is admittedly directed to “*storing ultimately captured images on film, rather than digitally in some sort of file format,*” to somehow arrive a system that would change the very principle of operation of Takagi, i.e., to modify the film-based camera of Takagi to one that stores *selected*, compressed, resultant, digital images in memory (as opposed to a selected camera setting used to capture an image on film). Absent such an explanation, it is respectfully submitted that the rejection of the claims is not only unduly speculative but could only have been arrived at from hindsight knowledge impermissibly derived from the subject

application. For at least these reasons it is respectfully submitted that the rejection of claims 1-24 and 28-39 fails to present a *prima facie* case of obviousness and must be withdrawn.

It is again respectfully submitted for the reasons set forth in the previously filed Appeal Brief that the specific rejections of claims 4, 5, 8, 9, 10, 17, 18, 21, 22, 23, 31, 32, 35, 36, 37 reflects not only an improper reliance upon Kagle (discussed further below) but similar reasoning that is not only unduly speculative but could only have been arrived at from hindsight knowledge impermissibly derived from the subject application. For at least this reason it is respectfully submitted that the rejection of these claims also fails to present a *prima facie* case of obviousness and must be withdrawn.

B. The Examiner's Answer As To The Rejection of Claims 25 and 27

In the Examiner's Answer it was again asserted that the teachings of Kagle suggest the modification of Takeda to arrive at the invention claimed. In response, it is respectfully submitted that the Examiner's Answer evidences an incorrect reading of Kagle and hence a reliance on a motivation to modify Takeda that does not exist within Kagle in the first instance.

Considering now Kagle, it is again submitted that Kagle describes a system in which a digital camera includes an orientation sensor and, when a picture is taken, the original picture is automatically rotated to correct for camera rotation prior to the picture being stored in the camera (without there being stored a corresponding indication as to the degree of rotation of the camera) or the original picture image is stored in the camera as taken (i.e., without being rotated) along with the degree of rotation of the camera to thereby allow the stored picture image to be rotated to correct for camera rotation when the picture is viewed on a device external to the camera. (Col. 3, lines 55+). Thus, contrary to the position taken by the Examiner, within Kagle not every

image is necessarily stored in the “landscape” orientation, not every image is necessarily stored with a degree of rotation of the camera (*and is particularly not stored with a degree of camera rotation when the image is rotated prior to its being stored*), and, as such, Kagle simply does not teach that altering an original image by rotating or flipping “is a conventional way of altering the content of an originally captured image for the purpose of uniform storage” as alleged in the Examiner’s Answer as the motivation for the espoused modification of Takeda. (Page 23).

Furthermore, contrary to the position taken in the Examiner’s Answer, while Kagle may disclose maintaining the orientation of a camera along with an original image that is captured by the camera, the flags do not “indicate the degree to which each image was rotated (when stored) as compared to its corresponding original image (as captured).” (Page 22). Rather, as discussed above, if the image was rotated when stored no flag is stored (and the image is therefore not re-rotated when displayed) and if a flag is stored that indicates a degree of rotation of the camera, the image was not rotated when stored (but is rotated for the first time using the data when displayed). Thus, nothing from with Kagle can be said to disclose, teach, or suggest modifying Takeda to include storing data indicative of whether a compressed image was rotated/flipped as compared to its original image and a program which *then* uses said data to re-rotate or re-flip the image such that it is displayed in a manner that corresponds to its original image as is claimed. For this reason, it is again respectfully submitted that a *prima facie* case of obviousness has not been established and the rejection of claims 25 and 27 must be withdrawn.

C. Conclusion

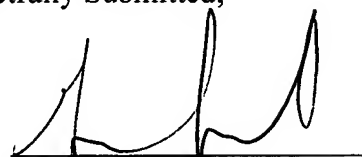
It is respectfully submitted that the application is in good and proper form for allowance.

Such action of the part of the Board is respectfully requested.

Respectfully Submitted;

Date: March 7, 2006

By:

A handwritten signature in black ink, appearing to read 'Gary R. Jarosik', written over a horizontal line.

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